

Application No. 10/767,520

**Remarks**

**I. Introduction**

This is in response to the Office Action dated November 16, 2009.

The Office Action objected to claims 19-22 because of informalities.

The Office Action rejected claims 19-22 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

The Office Action rejected claims 19-22 under 35 U.S.C. §101 as being directed to nonstatutory subject matter.

Claim 19 has been amended. No new matter has been added.

Claims 19-22 are pending.

**II. Claim Objections**

The Office Action objected to claims 19-22 because of informalities. In particular, the Examiner suggests "removing the term 'local' from 'the local non-broadcast multiple access interface' in lines 5 and 8 [of claim 19], in consistent with the claim language in the preamble." This suggested change is not necessary. The preamble of claim 19 recites "A method of operating a router in a communication network comprising a plurality of routers, the router having a plurality of **local** non-broadcast multiple access interfaces to at least one connection-oriented non-broadcast multiple access network". Accordingly, the term "local non-broadcast interfaces" in lines 5 and 8 of claim 19 is consistent with the language of the preamble. Therefore, withdrawal of this objection to claims 19-22 is respectfully requested.

Application No. 10/767,520

### III. Rejection under 35 U.S.C. §112

The Office Action rejected claims 19-22 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. In order for an invention to be enabled, the specification must contain "sufficient information regarding the subject matter of the claims as to enable one of ordinary skill in the pertinent art to make and use the claimed invention." MPEP §2164.01. The standard for determining if a claimed invention is enabled requires that "the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation." See *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). MPEP §2164.01. The specification, at least at lines 249-307 of the specification and FIG. 2, enable one of ordinary skill in the art to make and use the inventions of claims 19-22 without undue experimentation. The Office Action presents no evidence as to any undue experimentation that would be necessary for one of ordinary skill in the art to make and use the claimed invention. Therefore, claims 19-22 are enabled by the specification, and withdrawal of the rejections under 35 U.S.C. §112, first paragraph are respectfully requested.

In the first paragraph of page 3 of the Office Action, the Examiner alleges that the term "non-broadcast multiple access" or "NBMA" in the preamble of claim 19 is non-descriptive in light of the specification. The Examiner states "an NMBA network can be any type of network of routers connected together. Accordingly, the non-broadcast feature serves no special purpose because it is not used in the body of the claims." It is respectfully pointed out that this argument is irrelevant to whether an NMBA network is enabled by the specification. The specification, at page 7, lines 146-149, states that "[NBMA] network 110 is assumed to an ATM network, although those of skill in the art will easily recognize that the present invention has application to other connection-oriented networks." Thus, the limitation of an "NMBA network" is enabled by the specification.

Application No. 10/767,520

The second paragraph of page 3 of the Office Action states that "Examiner finds enabling details of the inventive concept not included in the claims." This paragraph then continues to describe various details that are described in the specification, but not included in the claims. It is respectfully pointed out that there is no requirement that every detail that is enabled by the specification must be included in the claims. What is required is that the invention recited in the claims be enabled by the specification. As described above, the limitations of claims 19-22 are clearly enabled by the specification.

In third paragraph of page 3 (continuing to page 4) of the Office Action, the Examiner states that "Specification, p.7 and Fig. 1 discloses an NBMA network 110 where routers R1-R6 are connected together. There is one network. Fig. 1 does not disclose 'a communication network of a plurality of routers' separate from 'at least one connection-oriented NBMA network'." However, FIG. 1 shows network 100 and NBMA network 110. As described at page 7, lines 144-146 of the specification, "[t]he network 100 has multiple routers 131-137, some of which are coupled to a connection oriented non-broadcast multiple access (NBMA) network 110." In particular, in FIG. 1, routers R1-R7 are connected to each other in communication network 100. Routers R1-R6 are connected to the NBMA network 110, and router R7 is not connected to the NBMA network 110. Thus, FIG. 1 clearly shows "a communication network comprising a plurality of routers" (communication network 100) and "at least one connection-oriented non-broadcast multiple access network" (NBMA network 110). Thus, these limitations of claim 19 are clearly enabled by the specification.

On page 4, the Office Action further rejects claims 19-22 under 35 U.S.C. §112, first paragraph, stating "since the claimed invention is not supported by either a specific substantial asserted utility or a well established utility for the reasons set forth above [in a 35 U.S.C. §101 rejection], one skilled in the art clearly would not know how to use the claimed invention." Independent claim 19 recites "a method of operating a router". This method is supported in the

Application No. 10/767,520

specification at least by FIG. 2 and the related description. As described at page 12, lines 262-263, FIG. 2 illustrates a procedure for a router to determine NBMA connectivity. Accordingly, a specific utility for the invention is described in the specification, and one skilled in the art would clearly know how to use the claimed invention in light of the specification.

For the reasons described above, the inventions of claims 19-22 are enabled by the specification. Therefore, withdrawal of the rejections of claims 19-22 under 35 U.S.C. §112, first paragraph is respectfully requested.

#### IV. Rejection Under 35 U.S.C. §101

The Office Action rejected claims 19-22 under 35 U.S.C. §101 as being directed to nonstatutory subject matter. In particular, the Office Action states that "the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility." Independent claim 19 recites "a method of operating a router". This method is supported in the specification at least by FIG. 2 and the related description. As described at page 12, lines 262-263, FIG. 2 illustrates a procedure for a router to determine NBMA connectivity. Accordingly, the claimed invention is supported by a specific asserted utility.

The Office Action further states that the "claimed invention is unclear whether it is supported by layer 2 and 3 networking, subnetworks, intra-area and inter-area, virtual circuitry and shortcut protocol such as OSPF and/or SNMP". It is respectfully pointed out that that the Office Action is applying an incorrect standard to determining whether the method claims of claims 19-22 are directed to patentable subject matter. According to the Federal Circuit, "a claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." In re Bilski, 545 F.3d 943 (Fed. Cir. 2008). Independent claim 19 is directed to "a method of operating a router" and each step of the claimed method

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Application No. 10/767,520

is tied to a router. Therefore, independent claim 19 and dependent claims 20-22 are clearly tied to a particular apparatus. Thus, claims 19-22 are directed to statutory subject matter and the withdrawal of rejection of claims 19-22 under 35 U.S.C. §101 is respectfully requested.

V. Conclusion

For the reasons discussed above, all pending claims are allowable over the cited art. Reconsideration and allowance of all claims is respectfully requested.

Respectfully submitted,

/Steven M. DiPasquo/  
Steven M. DiPasquo  
Reg. No. 54,754  
Tel.: 973-530-2076

Date: February 16, 2010